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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,249	12/05/2001	Michael John Stephen Austin	S63.2-10014	8321
490	7590	11/22/2004	EXAMINER	
VIDAS, ARRETT & STEINKRAUS, P.A. 6109 BLUE CIRCLE DRIVE SUITE 2000 MINNETONKA, MN 55343-9185			THALER, MICHAEL H	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/683,249

Applicant(s)AUSTIN, MICHAEL JOHN
STEPHEN**Examiner**

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28,30,33 and 36-38 is/are pending in the application.
- 4a) Of the above claim(s) 4,10-28,30 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9 and 36-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Sep. 20, 2004 has been entered.

In view of the papers filed Sep. 20, 2004, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding Barry O'Brian as an inventor.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Claims 4, 10-28, 30 and 33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable

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generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

Claims 1-3, 5-9 and 36-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if the term "cells" used throughout the claims is meant to refer to the openings within the stent wall or the physical material which bounds the openings. If the former is correct, than "openings" in claim 1, lines 4 and 7 are the same as the "cells" in lines 6 and 9 and therefore are duplicate recitations of the same element. If the latter is correct, than it is not seen how the cells could be "bounded only be self-expanding material" as defined in claim 5, lines 2-3, since the cells are the same as the self-expanding material which surrounds the openings.

Claims 1-3, 5-7, 9 and 36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Vonesh et al. (WO 00/33770). Vonesh et al., in figure 9, disclose a first balloon expandable segment (e.g. section 56 at the extreme left side of the figure), a second balloon expandable segment (e.g. section 56 at the middle of the figure) and a first self-expanding segment (e.g. the section 58 between the first and second balloon

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expandable segments). The balloon expandable segments may be not self-expanding as indicated on page 17, lines 5-9. Further, the balloon expandable segments each have openings therethrough, the openings extending all the way through the sidewall of the stent, since the balloon expandable segments are formed of porous material (page 13, lines 10-15). Alternatively, it would have been obvious that the openings extend all the way through the sidewall of the stent, since the balloon expandable segments are formed of porous material. Note that the Vonesh et al. balloon expandable segments each have cells as claimed, which are the formed of the material which surrounds the openings. As to claim 2, the sections 56 at the extreme left and right sides of the figure may be considered to be the claimed first and second balloon expandable segments while the two sections 58 may be considered to be the first and second self-expanding segments which are between the first and second balloon expandable segments. As to claim 3, the section 56 in the middle of the stent is considered to be the third balloon expandable segment. As to claim 5, the self-expanding cells are provided at intermediate islands 58 which are surrounded (on both sides) by balloon expandable material. As to claim 36, Vonesh et al. disclose a covering (the graft material) which is inherently protective.

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Claims 8 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vonesh et al. (WO 00/33770). Vonesh et al., in the figure 9 embodiment, fail to disclose more balloon expandable cells than self-expandable cells. However, Vonesh et al., in other embodiments (e.g. figures 6 and 8) teach that the balloon expandable sections 56 may extend for a longer axial distance than the self-expandable sections 58. This arrangement has the advantage of providing a specific flow characteristic as described on page 17, lines 3-9. It would have been obvious to lengthen the balloon expandable sections 56 in the figure 9 embodiment so that it too would have this advantage.

Claims 1-3, 5-9, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vrba (6,168,621). Vrba, in the embodiment of figure 6, discloses a first balloon expandable segment 14 and a first and second self-expanding segments 12, 12. Vrba, in this embodiment, fails to disclose a second balloon expandable segment. However, Vrba teaches that the stent according to the invention may be comprised of more than one balloon expandable part and that any combination of balloon expandable parts and self-expanding parts are within the scope of the invention (col. 2, lines 50-53). It would have been obvious to include more than two balloon expandable parts in the embodiment of figure 6 view of this teaching. Further, it would

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have been obvious to locate a self-expanding part between the two balloon expandable parts since all of the embodiments disclosed show the self-expanding parts and balloon expandable parts alternating with one another along the length of the stent. As to claim 5, the self-expanding part located between the two balloon expandable parts as described above is the claimed intermediate island.

Claim 38 is rejected under 35 U.S.C. 102(b) as being anticipated by Vonesh et al. (WO 00/33770). Vonesh et al., in figure 9, disclose a first balloon expandable segment (e.g. section 56 at the extreme left side of the figure), a second balloon expandable segment (e.g. section 56 at the extreme right of the figure) and a plurality of self-expanding segments (e.g. the top half of one section 58, the bottom half of this section 58, the top half of the other section 58, the bottom half of the other section 58). The top half of one section 58 is longitudinally and circumferentially offset from the bottom half of the other section 58. Each of the halves of sections 58 is a "segment" as broadly claimed. Webster's II New Riverside Dictionary defines "segment" as "Any of the parts into which something can be divided: SECTION.". The same dictionary defines "section" as "A part or piece of something: PORTION.". The top and bottom halves of section 58 are clearly parts into

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which section 58 can be divided. Further, the top and bottom halves of section 58 are clearly parts or portions of section 58. Thus, each of the halves of sections 58 are "segments". The balloon expandable segments may be not self-expanding as indicated on page 17, lines 5-9. The Vonesh et al. self-expanding cells are made of shape memory material (page 9, lines 5-8). The Vonesh et al. stent has a distal-most end and a proximal-most end, each constructed of balloon expandable material (at 56).

Applicant's arguments filed Sep. 20, 2004 have been fully considered but they are not persuasive for the reasons set forth above. Further, claim 5 does not require one of the islands to be an end island, noting the terms "either" and "or" in the phrase "at least one of the islands being either an end island located at an end of the stent or an intermediate island located between the ends of the stent" in lines 5-7. Since Vonesh et al. disclose the island as being an intermediate island located between the ends of the stent, it is not necessary for the reference to disclose the claimed specifics of an end island.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

mht
11/18/04



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731